UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,076	01/25/2001	Michael D. Krysiak	P/35-4	7143

7590 06/25/2010

Philip M. Weiss, Esq.
Weiss & Weiss
300 Old Country Road
Suite 251
Mineola, NY 11501

EXAMINER	
VALENTI, ANDREA M	
ART UNIT	PAPER NUMBER
3643	

MAIL DATE	DELIVERY MODE
06/25/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/769,076	KRYSIAK ET AL.	
	Examiner	Art Unit	
	ANDREA M. VALENTI	3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 April 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30,32,36-42 and 45-53* is/are pending in the application.

4a) Of the above claim(s) *1-25,36,37,39-42,45,46,48,49,51 and 53* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *26-30, 32, 38, 47, 50, 52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 26, 27, and 38 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,021,598 to Holton.

Regarding Claim 26, 27, 38, Holton teaches a colored mulch product (Holton abstract) consisting essentially of: a material comprising a fiber cellulose, clay, loam, sand, and/or a combination of same; a binding agent (Holton, water claim 1); and a dye and/or pigment (Holton Col. 4 line 8-10); the mulch product not being in a form of a mat (Holton Col. 6 line 1-24). Holton teaches a dye and that the dye indicates to a user environmental conditions of the soil where the mulch is placed. The mulch of Holton includes a dye, seed and a fertilizer (Holton Col. 6 line 1-3). Therefore, when the user sees the mulch color the user will known that mulch has been applied to that portion of soil along with a fertilizer/seed i.e. that soil portion has been fertilized/seeded which is an environmental condition.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

> the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 26, 27, 28, 29, 30, 38, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,021,598 to Holton in view of U.S. Patent No. 6,019,062 to Lombard et al.

Regarding Claim 26, 28, 29, 30 and 50, Holton teaches a colored mulch product (Holton abstract) consisting essentially of: a material comprising a fiber cellulose, clay, loam, sand, and/or a combination of same; a binding agent (Holton Claim 1, water); and a dye and/or pigment (Holton Col. 4 line 8-10). Holton teaches a dye, but is silent on the dye **indicates** to a user environmental conditions of the soil where said mulch is placed; the dye **indicates** to a user the acidity of said soil; the dye **indicates** to a user the moisture content of said soil; or the dye **indicates** to a user the chemical content of said soil and it is an environmentally safe dye (Lombard abstract second to last line).

However, Lombard et al teaches a dye indicator i.e. a pH indicating dye for application to cellulosic material such as paper (Lombard Col. 2 line 1-5 and Col. 2 line 11-15; Col. 2 line 60-67). It would have been obvious to one of ordinary skill in the art to modify the teachings of Holton with the teachings of Lombard at the time of the invention since the modification is merely an engineering design choice involving the selection of a known alternate dye selected for the known advantage of monitoring pH levels as taught by Lombard and is an environmentally safe dye as taught by Lombard (Lombard abstract).

Regarding Claim 27, Holton as modified teaches the mulch comprising; nitrogen, phosphorous, and potassium fortifiers (Holton Claim 8).

Regarding Claim 38, Holton as modified teaches the mulch is the same or similar color of an actual plant, flower, fruit, or vegetable of a seed planted with the mulch (Holton Col. 4 line 8-10).

Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,021,598 to Holton in view of U.S. Patent No. 6,019,062 to Lombard et al as applied to claim 26 above, and further in view Japanese Patent JP 01262735 A to Yanmar Agricult Equip Co LTD (Yamada).

Regarding Claim 52, Holton as modified teaches a method of placing colored mulch on top of soil; changing the colors of the mulch based on the condition of the soil. Holton is silent on adding chemicals to the soil based on the color of the mulch. However, it is old and notoriously well-known in the art of plant husbandry to observe and test soil conditions to see if they meet the desired parameters and to adjust the parameters when necessary. Yanmar teaches the general knowledge of one of ordinary skill in the art to add fertilizer when the pH is out of desired range (Yanmar abstract and Fig. 1 #2). General knowledge that the pH of a growing medium component determines the addition of fertilizer. It would have been obvious to one of ordinary skill in the art further modify the teachings of Holton with the teachings of Yanmar at the time of the invention for the advantage of promoting healthy plant development. Examiner takes official notice that it is old and notoriously well-known to add fertilizer based on a pH of the soil e.g. tomato plants prefer a certain acidity in the soil for healthy development so it is general practice to test the pH to determine if and how much fertilizer is needed.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,021,598 to Holton in view of U.S. Patent No. 6,019,062 to Lombard et al as applied to claim 26 above, and further in view of U.S. Patent No. 5,734,167 to Skelty.

Regarding Claim 32, Holton as modified teaches coloring the mulch, but is silent on the dye is florescent. However, Sketly teaches it is old and notoriously well-known to dye agricultural products with florescent dye allowing the mulch to glow in the dark (Skelty Col. 1 line 35-45). It would have been obvious to one of ordinary skill in the art to further modify the teachings of Holton with the teachings of Skelty at the time of the invention since the modification is merely the selection of a known alternate coloring for the advantage of enabling safe night time agricultural operations as taught by Skelty (Skelty Col. 1 line 1-26).

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,067,140 to Thomas in view of U.S. Patent No. 6,019,062 to Lombard et al.

Regarding Claim 47, Thomas teaches a colored mulch product (Thomas abstract) comprising: a material comprising a fiber cellulose (Thomas abstract first line), clay, loam, sand, and/or a combination of same; a binding agent (Thomas Col.1 line 30 “wetting agent” and Col. 4 line 35-41); and a dye and/or pigment (Thomas Col. 1 line 35) produced by a lifting and tumbling agglomeration operation (Thomas Col. 2 line 65-66. Thomas teaches adding fertilizer to the mulch mixture (Thomas Col. 1 line15). The language “indicates to a user environmental conditions of the soil where the mulch is

place" is functional language/result of the use of the product that the product is "capable" of performing. The applicant has not claimed a specific type or special dye; applicant has not claimed what environmental conditions; applicant has not claimed how the dye works. Applicant has merely claimed a dye. The color from the dye is capable of indicating to the user that the mulch has been placed on a desired surface and that the environmental condition of the soil under that mulch is in a stage of fertilization since fertilizer is present in the mulch and over time with be absorbed into the soil. The mulch can also container seeds (Thomas Col. 1 line 15), so when the mulch with is placed in position and has seeds present it indicates to the under that the “environmental condition" of that soil area is “planted”. Applicant has not patentably distinguished over the prior art of record. It can also be argued that Thomas is silent on the dye indicates to a user the environmental conditions of the soil where the mulch is place. However, Lombard et al teaches a dye indicator i.e. a pH indicating dye for application to cellulosic material such as paper (Lombard Col. 2 line 1-5 and Col. 2 line 11-15; Col. 2 line 60-67). It would have been obvious to one of ordinary skill in the art to modify the teachings of Stevens with the teachings of Lombard at the time of the invention since the modification is merely an engineering design choice involving the selection of a known alternate dye selected for the known advantage of monitoring pH levels as taught by Lombard.

Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,324,781 to Stevens in view of U.S. Patent No. 5,697,984 to Swatzina et al.

Regarding Claim 50, Stevens teaches a colored mulch product wherein the color, but is silent on the mulch product fades or disappears in response to a lack of fertilizer in the mulch. Stevens teaches the mulch product is made up of fertilizer (Stevens abstract last sentence), mulch plus fertilizer makes a mulch product. Swatzina teaches it is old and notoriously well-known to color fertilizer (e.g. red fertilizer Swatzina; Col. 2 line 31-33 and Example 4). One of ordinary skill in the art would be motivated to modify the teachings of Stevens with the teachings of Swatzina at the time of the invention for a desired aesthetic design. Stevens as modified by Swatzina, i.e. the selection of red fertilizer, would inherently teach that as the red disappears or fades from the mulch the fertilizer is disappearing too.

Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,021,598 to Holton in view of U.S. Patent No. 5,697,984 to Swatzina et al.

Regarding Claim 50, Holton teaches a colored mulch product wherein the color, but is silent on the mulch product fades or disappears in response to a lack of fertilizer in the mulch. Holton teaches the mulch product is made up of fertilizer (Holton Claim 8), mulch plus fertilizer makes a mulch product. Swatzina teaches it is old and notoriously well-known to color fertilizer (e.g. red fertilizer Swatzina; Col. 2 line 31-33 and Example 4). One of ordinary skill in the art would be motivated to modify the teachings of Holton with the teachings of Swatzina at the time of the invention for a desired aesthetic design. Holton as modified by Swatzina, i.e. the selection of red fertilizer, would

inherently teach that as the red disappears or fades from the mulch the fertilizer is disappearing too.

Response to Arguments

Applicant's arguments filed 08 April 2010 have been fully considered but they are not persuasive.

The declaration by Mr. Holton filed 08 April 2010 is insufficient to overcome the rejection of claims as set forth in the last Office action because:

First, regarding claims 26, 27, and 38, the claim language is very broad in nature. It merely states that "said dye indicates to a user environmental conditions of the soil where the mulch is placed". Applicant hasn't claimed specific environmental conditions. The mere fact that the area is mulched the environmental condition of the soil can merely be the soil has been mulched. Alternatively, the fact that the mulch is mixed with seeds and fertilizers the dye indicates that area is mulched and thus the environmental condition of the soil is seeded and fertilized. Even though Mr. Holton didn't intend for his invention to be an indicator, it inherently is an indicator. The green mulch of Mr. Holton indicates that the soil has been mulched, seeded and fertilized. The fact that Mr. Holton has recognized another advantage/another intended use, i.e. increased aesthetic appeal of green mulch, does not patentably distinguish applicant's invention. ***The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).***

The examiner maintains that the teachings of cited prior art Holton satisfies each and every limitation of the ***broadly worded*** claim. In addition, Holton even identifies how the mulch effects the environmental conditions of the soil (Holton Col. 2 line 34-38). When the user sees the green color i.e. the dye the user knows that the soil is under these current environmental conditions.

Second, regarding claims 26, 27, 28, 29, 30, 38, and 50, the examiner made a typographical error in the text of the rejection of Holton in view of Lombard by typing "Stevens." This typographical error should have been "Holton", it was clear from the dialogue of the rejection that the examiner intended Holton. The examiner maintains the combination of Holton modified by Lombard. The modification is merely an obvious modification ***for one or ordinary skill in the art***, not Mr. Holton. There is motivation found in the teachings of Lombard to modify the teachings of Holton. Holton teaches that the dye is an aesthetic feature. Changes in an aesthetic/ornamental design feature is an obvious modification for one of ordinary skill in the art [*In re Seid*, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947)]. Lombard teaches the advantage of a dye that monitors pH levels. The modification of Holton by Lombard is an obvious modification for one of ordinary skill in the art for the known advantage taught by Lombard i.e. the simple substitution of one known element (dye) for another to obtain predictable results.

Lombard is reasonably pertinent to the particular problem with which applicant was concerned i.e. a means of providing a dye to a paper substrate. Holton even discusses how an area that animal has urinated on has a higher urea content (Holton Col. 2 line 15 and Col. 2 line 24).

Lombard teaches an environmentally safe dye for application to fiber cellulosic base material. Lombard teaches the dye can change from a blue to red (Lombard abstract) which could be considered an aesthetic effect too. It can also be argued that Holton teaches a fertilizer application and animal urine is an old and notoriously well-known fertilizer component that is particularly desirable for application around plants that have a high nitrogen requirement. It can be argued that the motivation to combine the reference could also be to tell where an animal has urinated to identify the environmental condition of fertilization. In other words, it would have been obvious to modify/substitute the colored dye taught by Holton with the dye of Lombard in order to identify animal urination as taught by Lombard to known an area has received nitrogen fertilization. Again, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Third, regarding claim 52, the examiner is combining the teaching of Holton modified by Lombard and further modified by Yanmar. Holton teaches placing a dyed mulch on the soil. It is modified by the alternate dye of Lombard that changes color. Yanmar is a teaching of general knowledge in the art that when a noticeable change in pH has occurred it is desirable to add fertilizer. Therefore, the examiner is not going against the teachings of Mr. Holton. Again, merely modifying an aesthetic effect does not present a patentably distinct limitation over the prior art of record. The modification

of the teachings of Lombard is merely a modification to the aesthetic effect of Holton for the known advantage taught by Lombard.

The examiner maintains that Holton teaches a cellulosic fiber base with a dye that gives it color; Lombard is cited as general knowledge in the art of a known alternate environmentally friendly dye that is well received by a cellulosic fiber base. It has been discussed in the above paragraphs that there is motivation found in the art to combine the teachings for the colored red/blue aesthetic effect taught by Lombard along with the ability to determine if an animal has urinated in a certain region i.e. released nitrogen components into an environmental region. Holton is concerned with promoting plant growth and providing fertilizer. Yanmar teaches general knowledge in the art that healthy plant growth requires monitoring the pH to know when more fertilizer is necessary. *The combination is merely the application of a known technique to a known device ready for improvement to yield predictable results*.

Fourth, regarding claim 32, the examiner maintains the combination of Holton as modified by Lombard and Skelty. Merely modifying an aesthetic effect does not present a patentably distinct limitation over the prior art of record. The modification of the teachings of Skelty is merely a modification to the aesthetic effect of Holton for the known advantage taught by Skelty.

Fifth, regarding claim 47, the examiner has not changed the claim language of the claims. It is an apparatus claim, not a method claim. Applicant has merely claimed "said dye *indicates* to a user environmental conditions of the soil where the mulch is place". The claim language merely presents a result a functional result of the dye. The

dye of Holton is capable of satisfying the broad nature of the claimed functional result. The applicant has not claimed a specific type or special dye; applicant has not claimed what environmental conditions; applicant has not claimed how the dye works. Applicant has merely claimed a dye. The color from the dye is capable of indicating to the user that the mulch has been placed on a desired surface and that the environmental condition of the soil under that mulch is in a stage of fertilization since fertilizer is present in the mulch and over time with be absorbed into the soil. The mulch can also container seeds (Thomas Col. 1 line 15), so when the mulch with is placed in position and has seeds present it indicates to the under that the “environmental condition" of that soil area is “planted”.

Sixth, regarding claim 50, Stevens in view of Swatzina, it is the examiner’s position that Steven teaches a mulch mat with fertilizer added to it. The teachings of Swatzina are only provided to teach the general knowledge in the art that it is known to color fertilizers. Together the mulch and fertilizer make up the mulch product. Thus, Swatzina is cited to provide a colored fertilizer that acts as a visual indicator and is not cited to teach dying the mulch taught by Stevens another color. Furthermore, Stevens Col. 6 line 35-37 merely states that color “may be” i.e. can be added to the mulch and *just one example of a color that can be selected is green*. Stevens does not teach that the mulch product has to be a green and only green color.

Seventh, regarding claim 50 Holton in view of Swatzina, Holton teaches a colored mulch product. Holton teaches that the mulch product is dyed green. Holton teaches that the fertilizer and seed are added to the dyed mulch product onsite i.e. at a

later time (Holton Col. 5 line 40-50 and Col. 5 line 24-25). Holton doesn't teach that the fertilizer has to be green in color too. Therefore, there is no reason why one of ordinary skill in the art wouldn't look to the teachings of Swatzina for a known form of fertilizer to add to the green mulch product of Holton.

Examiner maintains that applicant has not patentably distinguished over the teachings of the cited prior art of record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREA M. VALENTI whose telephone number is (571)272-6895. The examiner can normally be reached on 6:00am-4:30pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrea M. Valenti/
Primary Examiner, Art Unit 3643

21 June 2010